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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,380	04/06/2005	Ralph Hubert Peters	NL020989US	4939
24737 7590 07/29/2008 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510				
EXAMINER				
DUNN, DANIELLE N				
ART UNIT		PAPER NUMBER		
2875				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/530,380

## Applicant(s)

PETERS ET AL.

## Examiner

Danielle Dunn

## Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

Applicant's amendment filed on 5/09/2008 has been entered. Claims 1 and 12 have been amended. No claims have been cancelled. No claims have been added. Claims 1-20 are still pending in this application, with claims 1 and 12 being independent.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 6, 7, 9, 11, 12, 15-16, 18 and 20** are rejected under 35 U.S.C. 102(b) as being anticipated by Toombs (US 5,654,552).

With respect to **claims 1, 6, 7, 9, 11, 12, 15-16, 18 and 20**, Toombs teaches an illumination device (lamp shade 130) having a light means for generating primary light (light bulb 136) and a light emitter (pattern 132) having an after-glowing material (glow-in-the-dark ink; Col 5, ln 56) for emitting secondary light after the light means is switched off or has extinguished. Toombs also teaches the after-glowing material being shaped in a predetermined pattern (pattern 132) that is configured to display information (pattern 132 is of the moon, therefore symbolizing night time or bed time) and it is substantially invisible when the light means is generating the primary light (during illumination by light bulb 136, pattern 132 absorbs energy and background 134 absorbs

approximately the same spectrum of light so that pattern 132 is not visible as suggested by the dashed outline; Fig. 7).

Toombs further teaches the predetermined pattern being distributed throughout a portion less than the entire portion of the light transmissive material, wherein the illuminating device is configured to only allow viewing of the primary light through the light transmissive material (lamp shade 130 is a light transmissive material and pattern 132 is distributed throughout a portion less than the entire portion of the lamp shade as shown in Fig. 7). The applicant is advised that it has been held by the courts that the recitation that an element is adapted to or configured to perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In this case, the illuminating device has the ability to be configured to only allow viewing of the primary light through the light transmissive material.

Toombs teaches the predetermined pattern of the after –glow material comprising at least one of an alphanumerical character, a logo, and an arrow (pattern 52 which is the same as pattern 132 could have any shape, size or position; Col. 4, In 56-57; Figs. 3 and 7). Toombs teaches the use of a “glow-in-the-dark” substance (Col. 2, In 64-Col. 3, In 5) which anticipates the use of a photoluminescent or phosphorescent material. Toombs teaches a luminaire comprising a housing (lamp shade 130) having a light emission window (the side of lamp shade 130 that is opposite light bulb 136), the housing or the light-emission window being provided with the light-emitter according to

claim 1 (pattern 132). Toombs teaches a display window being provided with the light emitter (lamp shade 130 is provided with pattern 132 creating a display window).

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. **Claims 2, 3 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Toombs (US 5,654,552) as applied to claims 1 and 12 above, and further in view of Stone (US 3,769,869).

With respect to **claims 2, 3, and 14**, Toombs teaches the limitations as disclosed above. Toombs teaches "light in the visible range" being light that in the range of frequencies that can be visually perceived by a human viewer (Col. 2, In 48-50). Toombs also teaches the definition of "glow-in-the-dark" (Col. 2, In 46 – Col. 3, In 5). Toombs does not appear to explicitly disclose the intensity  $I_{lm}$  of the primary light emitted by the light means as compared to the secondary intensity  $I_e$  of the secondary light such that  $I_e/I_{lm} < 0.5$ . However, Stone teaches that a primary intensity of the primary light as compared to a secondary light is at least one of  $I_e/I_{lm} < 0.5$  (Column 4, lines 50-55) and  $I_e/I_{lm} < 0.1$  (Column 2, lines 50-52). Therefore, at the time of the invention it would have obvious to one of ordinary skill in the art, having the teachings Toombs and Stone before him or her to have primary and secondary intensities on the device of Toombs for the benefit of varying the amount of time the after-glow last, as taught by Stone.

5. **Claims 4, 5 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Toombs (US 5,654,552) as applied to claims 1 and 12 above, and further in view of DeLine et al. (US 6,172,613).

With respect to **claims 4, 5, and 13**, Toombs teaches all the limitations as disclosed above. Toombs does not appear to explicitly disclose the initial light output following the switching off or the extinguishing of the light means is lower than  $3 \text{ cd/m}^2$ . However, DeLine et al. teaches a level of secondary light (item 424 shown in Fig. 18) is at least one of equal to lower than  $3 \text{ cd/m}^2$  and equal to or lower than  $1 \text{ cd/m}^2$  (Column 30, lines 44-46). Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have the specified initial light output as taught by DeLine et al. on the device of Toombs for the benefit of displaying low level lighting as taught by DeLine et al.

6. **Claims 8 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Toombs (US 5,654,552) as applied to claims 1 and 12 above, and further in view of Apple (US 5,833,349).

With respect to **claims 8 and 17**, Toombs teaches all the limitations as disclosed above. Toombs teaches a lamp shade (lamp shade 130) and a light bulb (light bulb 136) which are used on a lamp. Toombs does not explicitly teach a lamp vessel provided with the light emitter as disclosed in claim 1. However, Apple teaches an electric lamp (shown in Fig. 1) comprising a lamp vessel provided with a light-emitter (the

phosphorescent additive is distributed uniformly throughout the clear plastic sheet of the lamp shade; Column 2, lines 3-7). Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to use the lamp shade of Toombs on the electric lamp of Apple, because this will provide an alternate lamp shades with "glow-in-the-dark substances to be used.

7. **Claims 1, 10, 12 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (US 2,459,693) and further in view of Toombs (US 5,654,552).

With respect to **claims 1, 10, 12 and 19**, Gordon teaches an illuminating device comprising light means for generating primary light (a two filament electric light bulb 3; Fig. 1) and a light-emitter (inner and outer lamination layers 8 and 10; Fig. 2) comprising an after-glowing material for emitting secondary light after the light means is switched off or has extinguished (the center layer 9 has incorporated therein phosphorescent material; Column 3, lines 32-42). Gordon teaches the after-glowing material being activated by the primary light emitted from the light means (Column 3, lines 37-42), and wherein the after-glowing material is shaped in a predetermined pattern (the three laminations 8, 9 and 10 may be individually molded or otherwise formed to exact or approximate shapes and then united into the structure; Column 3, lines 61-68) for displaying information. Gordon also teaches an automotive head lamp (lamp 1) comprising a housing (casing 2) having a light emission window (lens 4), the housing or the light-emission window being provided with the light-emitter according to claim 1

(layers 8, 9, and 10 are provided in lens 4; shown in Fig. 2). Gordon does not explicitly teach the after-glowing material being substantially invisible when the light means generates the primary light.

However, Toombs teaches an illumination device (lamp shade 130) having a light means for generating primary light (light bulb 136) and a light emitter (pattern 132) having an after-glowing material (glow-in-the-dark ink; Col 5, In 56) for emitting secondary light after the light means is switched off or has extinguished. Toombs also teaches the after-glowing material being shaped in a predetermined pattern (pattern 132) that is configured to display information (pattern 132 is of the moon, therefore symbolizing night time or bed time) and it is substantially invisible when the light means is generating the primary light (during illumination by light bulb 136, pattern 132 absorbs energy and background 134 absorbs approximately the same spectrum of light so that pattern 132 is not visible as suggested by the dashed outline; Fig. 7). Toombs further teaches the predetermined pattern being distributed throughout a portion less than the entire portion of the light transmissive material (lamp shade 130 is a light transmissive material and pattern 132 is distributed throughout a portion less than the entire portion of the lamp shade as shown in Fig. 7).

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art having the teachings of Gordon and Toombs before him or her to modify the middle of the three layers of Gordon to include the background with a pattern of approximately the same absorption color as the glow-in-the-dark ink of Toombs



because this would allow for several decorative patterns to be applied to a vehicle headlight.

***Response to Arguments***

8. Applicant's arguments filed 5/09/2008 have been fully considered but they are not persuasive.

9. In response to applicant's arguments that Toombs does not state that the patterns are configured to display information. The applicant is advised that it has been held by the courts that the recitation that an element is adapted to or configured to perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In this case, the after-glowing material being shaped in a predetermined pattern (pattern 132) that is configured to display information (pattern 132 is of the moon, therefore symbolizing night time or bed time).

10. In response to the applicant's arguments that the phosphorescent additive of Gordon being distributed uniformly is not a predetermined pattern. The Examiner notes that if a pattern is formed with one element uniformly distributed, then it is done in a predetermined fashion.

11. In response to applicant's argument regarding claims 2, 3, and 14, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a relative illumination intensity) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. In response to applicant's arguments regarding claims 4, 5, and 13 that DeLine et al. fail to disclose, or even suggest, an after-glowing property, the applicant is advised that in considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 159 USPQ 342 (CCPA 1968).

In this case, DeLine et al. teach electrophosphorescent light sources (col. 30, ln 36-37) may be used. DeLine et al. then further teaches, in night conditions, a candle power of 1 to 2 cd/m<sup>2</sup>, or lower, is preferred. Therefore, it would be reasonable to one skilled in the art to have the candle power of the after-glowing material to be 1 to 2 cd/m<sup>2</sup>, or lower (col. 30, ln 44-46).

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Dunn whose telephone number is (571)270-3039. The examiner can normally be reached on Monday thru Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571-272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2875

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sandra L. O'Shea/  
Supervisory Patent Examiner, Art  
Unit 2875

DND  
7/24/08